

REMARKS

The Amendments

Claim 1 is amended to address the 35 U.S.C. §103 rejection as discussed below. Claims 11-12, 14-15 and 17-20 are amended and claims 9 and 16 canceled to address the 35 U.S.C. §112 rejection.

It is submitted that the above amendments would put the application in condition for allowance or materially reduce or simplify the issues for appeal. The amendments do not raise new issues or present new matter and do not present additional claims. The amendments have been made to address the new grounds of rejection made in the Office action. Thus, they were not earlier presented. Accordingly, it is submitted that the requested amendments should be entered.

Applicants reserve the right to file one or more continuing and/or divisional applications directed to any subject matter disclosed in the application which has been canceled by any of the above amendments.

Request to Withdrawn Final Status of Office Action

It appears that possibly the indication on the cover page that the action is Final may be in error. The body of the action provides no indication that it is Final. It appears that the amendments made here may place the case in condition for allowance, in which case the Final status of the action is of no consequence. However, if the action was intended to be Final and the application is not allowed, applicants urge that the Final status be withdrawn. A Final rejection

was not appropriate in these circumstances after applicants' filing of an RCE. The claims rejected here are not the same claims previously rejected and were not subject to the same rejection for the same reasons. The reasoning of the rejection has changed from that made previously. In fact, the Office action previous to this one indicated that the subject matter which was claimed upon applicants filing of the RCE was allowable, i.e., claim 13 was previously indicated to be allowable. Additionally, the Office action contains a whole new rejection under 35 U.S.C. §112 which was not present in the previous action and was not necessitated by any amendment made by applicants.

The Rejection under 35 U.S.C. §103

The rejection of claims 1, 6 and 7 under 35 U.S.C. §103, as being obvious over Janssens (U.S. Patent No. 5,041,448), is believed to be rendered moot by the amendment.

The claims have been amended to remove the piperidin-2-yl-C₁₋₂-alkyl and piperidin-3-yl-C₁₋₂-alkyl groups from the R4 definition and the piperidinyl group from the R20 definition. The claims are thus no longer encompassing of the compounds alleged in the Office action to be position isomers of the prior art compounds. Since the rejection was based on the alleged position isomer relationship of the claimed compounds to the prior art compounds, the amendment to remove these compounds would appear to overcome the rejection.

Janssens specifically requires that their compounds have a piperidin-4-yl group bonded to the bicyclic ring structure of formula (I) through a bridging group B which is a single atom bridge, such as CH₂; see col. 1, lines 25-62. In other positions Janssens allows variance but is specific about the piperidin-4-yl structure and the single atom bridging group. The record fails to

provide a reason why one of ordinary skill in the art would modify the Janssens compounds in a way which would alter this required structure of Janssens. Particularly, there is no reason apparent from the record why one of ordinary skill in the art would modify the Janssens compounds not only in the position of the nitrogen atom in the piperidinyl ring but also in some other respect, such as by modifying the length or nature of the bridging group, B, or by replacing the piperidinyl group with a different group. Thus, Janssens fails to render the current claims obvious to one of ordinary skill in the art.

For the above reasons, it is urged that the rejection under 35 U.S.C. §103 over Janssens should be withdrawn.

The Rejection under 35 U.S.C. §112

The rejection of claims 9-12 and 14-20 under 35 U.S.C. §112, first paragraph, for lack of enablement is rendered moot by the above amendments. The type 1 diabetes recitation giving rise to the rejection is removed from the claims.

It is submitted that the application is in condition for allowance. But the Examiner is kindly invited to contact the undersigned to discuss any unresolved matters.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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